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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/297,483	07/19/1999	SHUNICHI SEKI	005317-20009	9831

26021 7590 06/03/2002

HOGAN & HARTSON L.L.P.  
500 S. GRAND AVENUE  
SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

CLEVELAND, MICHAEL B

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/03/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.:

09/297,483

Applicant(s)

SEKI ET AL

Examiner

Michael Cleveland

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 37-54, 56, 58, 62-63

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The proposed After Final amendment will not be entered because it raises new issues for further search and consideration, such as the presence of a lubricant in each independent claim, and diethylene glycol in particular. It also raises the issues whether claim 50 further limits its parent.

***Response to Arguments***

2. Applicant's arguments filed 5/28/02 have been fully considered but they are not persuasive.

Applicant's arguments regarding claims 37, 56, 62, and 63 regarding the use of a lubricant are unconvincing because the proposed amendment has not been entered. (However, see the rejection of claim 50.)

Applicant's arguments regarding the rejection of claim 58 over the Jonas patents are unconvincing for the reasons given in the final rejection. To wit: Applicant's argument regarding the viscosity and surface tension of the composition are not convincing because the claimed ranges of viscosities and surface tensions are well known as operable in printing methods (see, for instance, the references cited in the office action mailed 2/17/2000, especially Itoh '721 and Taniguchi '572), and therefore one of ordinary skill in the art would have expected to have used such viscosities and surface tensions with a reasonable expectation of success. The Examiner notes that Applicant has not stated that optimization of viscosity and surface tension is not obvious in coating processes in general, nor in the processes explicitly listed by Jonas. Applicant has merely challenged the Examiner's citation of Official Notice that flowability (and therefore viscosity) and wettability (and therefore surface tension) of coating compositions are well known as result-effective coating parameters and stated that no evidence of such was provided in the prior office action. The Examiner disagrees, given that the office action of 2/17/2000 was cited in the response to argument section of the prior office action. In the interest of citing further evidence of the assertion, the Examiner cites as evidence that the flowability and viscosity are result-effective parameters in a variety of coating processes. Brownlee et al. (U.S. Patent 3,913,825, col. 9, lines 24-47), Beyer et al. (U.S. Patent 3,952,698, col. 3, lines 47-63), Fefferman (U.S. Patent 4,459,320, col. 6, lines 51-60), Audykowski et al. (U.S. Patent 4,544,623, hereafter '623, col. 1, lines 21-43). The Examiner further cites as evidence that the wettability

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and surface tension are result-effective parameters in a variety of coating processes: Neer (U.S. Patent 5,680,893, col. 7, lines 25-46) and Andersen et al. (U.S. Patent 5,508,072, col. 57, lines 16-40).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (703) 308-2331. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-3186 for regular communications and (703) 306-3186 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

92-300  
MBC

May 30, 2002

SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700